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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,267

10/27/2004

Ryoto Shima

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5304

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EXAMINER

NGUYEN, KHANH TUAN

ART UNIT

PAPER NUMBER

1751

MAIL DATE

DELIVERY MODE

07/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,267

Applicant(s)

SHIMA ET AL.

Examiner

Khanh T. Nguyen

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is responsive to application's amendment/remarks filed 04/27/2007.

Claims 1-26 are current pending. This action is responsive to the amendment filed on 04/27/2007. Claims 1-26 are currently pending.

The rejection of claims 1-6, 10, and 20-24 and 7-12 rejected 35 U.S.C. 103(a) as being unpatentable over Takehashi et al., U.S Patent No. 5,482,978, in view of Shimizu et al., U.S. Patent No. 4,742,142 is withdrawn in view of Applicant's arguments.

The rejection of claims 7-9, 13-19 and 25-26 rejected 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. '978 patent in view of Shimizu et al. '142 patent, and further in view of U.S Patent No. 6,299,952 of Honma et al. is withdrawn in view of Applicant's arguments.

The rejection of claims 11 and 12 rejected 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. '978 patent in view of Shimizu et al. '142 patent, and further in view of U.S Patent No. 6,299 of Nakayoshi et al. is withdrawn in view of Applicant's arguments.

Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuda et al. (U.S Pat. No. 5,082,596 hereinafter, "Fukuda").

With respect to instant claims 1-26, Fukuda discloses an electrically conductive silicone rubber composition comprising of (a) 100 to 500 parts of diorganopolysiloxane having at least two alkenyl groups per molecule (Col. 2, lines 57-67 and Col. 3, lines 1-14); (b) spherical silicone rubber particles with the ratio of (a) to (b) from 95:5 to 50:50 (Col. 3, lines 15-27 and Col. 4, lines 1-2); (c) 5 to 100 parts by weight of carbon black (Col. 4, lines 44-56), however metal such as silver, nickel, copper and metal fibers may also be use (Col. 1, lines 35-42); (d) a curing agent(Col. 4, lines 57-61). The component (b) spherical silicone rubber particles may optionally be subject to a surface treatment with surface active agent (Col. 39-65). Fukuda also discloses platinum catalyst may be use to promote curing (Col. 5, lines 1-4). The prior art also discloses the composition may further admixed with various additives used in silicone rubber composition including reinforcing siliceous fillers, e.g., silica hydrogels and silica aerogels, non-reinforcing fillers, e.g., clay, calcium carbonate, diatomaceous earth and titanium dioxide, low-molecular siloxane esters and silanols, e.g., diphenyl silane diol, as a dispersing aid, heat-resistance improvers, e.g., iron oxides, ceric oxide and iron

Art Unit: 1751

octoate, various kinds of carbon-functional organosilanes to improve adhesion or workability of the composition, flame retardants, e.g. platinum compounds, and so on each in a limited amount (Col. 5, lines 15-27). The reference further discloses the conductive silicone rubber composition can be shaped and cured by molding method such as compression molding, transfer molding, extrusion molding, injection molding, calendaring and useful in applications in the office machines such as rollers of xerographic copying machines and keyboard coverings of pocketable calculators, electric and electronic instruments such as terminals of computers, transportation machines such as parts of automobiles and as well as in form of semiconductive rubber parts used for antistatic purpose (Col. 5, lines 53-67). The reference specifically or inherently meets each of the claimed limitations. The reference is anticipatory. In addition, the claims recitation of a new intended use for an old product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh T. Nguyen whose telephone number is (571) 272-8082. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone

Art Unit: 1751

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



KTN
Examiner
06/21/2007



Mark Kopec
Primary Examiner